

REMARKS

Claims 1 – 24 have been examined. Claims 1 – 5, 15, 16, 18, 21, 23, and 24 stand rejected under 35 U.S.C. §102(b) as anticipated by U.S. Pat. No. 5,583,561 (“Baker”); Claims 6 – 14, 19, and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over Baker in view of U.S. Pat. No. 5,357,276 (“Banker”); Claim 15 stands rejected under 35 U.S.C. §103(a) as unpatentable over Baker in view of U.S. Pat. No. 5,604,528 (“Edwards”); and Claims 17 and 22 stand rejected under 35 U.S.C. §103(a) as unpatentable over Baker in view of U.S. Pat. No. 5,530,754 (“Garfinkle”).

Claims 16, 17, 21, and 22 have been canceled. Limitations reciting that the server is located on a set-top box local to the user, as previously recited in Claims 17 and 22, have been added to each of the independent claims, i.e. to Claims 1, 18, and 23. In addition, each of these independent claims has been amended to recite that the counterpart in the second set of programs is substantially identical to the at least one of the first set of programs. The resulting combination in the claim language is intended to require that at least one of the first set of programs that is transmitted in real time have a substantially identical copy that is stored on a server located on a set-top box local to the user. Such an arrangement provides for transmission of broadcast programming according to a defined schedule, with some of the broadcast programs being available to be played on demand under a user’s control by also being stored on the local server (*see, e.g.*, Application, p. 5, ll. 1 – 8 describing the general functionality of the “club”).

The resulting combination of limitations is neither taught nor suggested by the cited art. For example, the Office Action acknowledges that “Baker does not teach using a server local to the subscriber” (Office Action, p. 7), relying on Garfinkle for such a limitation. But with the clarification that the counterpart in the second set of programs is substantially identical to the at least one of the first set of programs, it is respectfully believed that Garfinkle also fails to disclose the limitation. In particular, it appears that the Office Action is relying on the disclosure of Garfinkle to store a lead-in or trailer as disclosing that a counterpart to the at least one of the first set of programs be stored on a server local to a user. Such an interpretation

is now precluded by the clarification in the claims that "the counterpart in the second set of programs is substantially identical to the at least one of the first set of programs."

It is further noted that neither Baker nor Garfinkle teaches playing one of the second set of programs, i.e one of the programs located on a set-top box server, under the control of the user. While Baker does disclose program control, it is effected in an entirely different manner by using programs stored on remote servers, failing to achieve certain benefits that result from having such local storage (*see, e.g.*, Application, p. 11, ll. 7 – 13). Garfinkle also does not teach playing one of the programs located on a set-top box server under the control of the user.


For these reasons, it is believed that each of the independent claims is patentable over the cited art, and that the dependent claims are patentable by virtue of their dependence from patentable claims.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Patrick M. Boucher
Reg. No. 44,037

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
PMB:pmb